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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,097	08/14/2008	Thomas Schuster	P/746-10 V1408	4051

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OSTROLENK FABER GERB & SOFFEN
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NEW YORK, NY 100368403

EXAMINER

BROWE, DAVID

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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12/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,097	SCHUSTER ET AL.	
	Examiner	Art Unit	
	DAVID M. BROWE	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Applicants' amendments and arguments in the reply filed October 14, 2010 to the Non-final Office Action mailed July 15, 2010. Claims 1 and 8 have been amended; and no claims have been deleted or newly added. Claims 1-12 are pending in the application.

Withdrawal of Prior Claim Rejections - 35 USC § 103

Neither Schumacher *et al.* nor Argoitia *et al.* explicitly disclose that the effect pigments align parallel to skin surface whereby angle dependent effects would make the skin appear to have a different color or different color shade, as stipulated in the newly amended independent claims 1 and 8. Therefore, the 35 USC § 103 rejection of claims 1-12 presented in the Non-final Office Action mailed July 15, 2010 is hereby withdrawn. However, a new search and examination has been conducted, and a new grounds of rejection has been formulated that addresses all pending claim limitations, including the newly added limitations, and is presented herein below.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Müller-Rees *et al.* (U.S. Patent No. 5,851,277), in view of Schmid *et al.* (U.S. Patent No. 6,533,857).

Applicant Claims

Applicants claim a UV-protective cosmetic preparation for application to skin comprising one or more UV absorbers and effect pigments, wherein the effect pigments have a laminar structure, contain titanium dioxide, and have at least one protective coating of silicon dioxide isolating the titanium dioxide from its environment to prevent

Art Unit: 1617

breakdown of the UV absorbers, wherein said effect pigments align parallel to skin when said preparation is applied to skin, whereby, depending on the angle of incidence of light, the skin would appear to have a different color or a different color shade. The effect pigments are pearlescent pigments, have a layer-on-substrate build-up, and a transparent protective coating. The cosmetic preparation is a sunscreen agent in the form selected from the group consisting of a cream, lotion, milk, emulsion, spray emulsion, jelly, oil, spray oil, and an aerosol. The UV absorber is an organic UV absorber selected from the group consisting of benzophenones, hydroxynaphthoquinones, phenylbenzoxazoles, phenylbenzimidazoles, digalloyl trioleate, aminobenzoic acid esters, salicylic acid esters, acyclic dienones, cinnamic esters, benzalazine, avobenzene, paraaminobenzoic acid and derivatives thereof, cinnamates, salicylates, camphor derivatives, benzimidazoles, 4-isopropylidibenzoylmethane, 4-(1,1-dimethylethyl)-4'-methoxydibenzoylmethane, 2,4-dimethyl-4'-methoxydibenzoylmethane and mixtures thereof.

Applicants also claim a method for the production of a UV-protective cosmetic preparation that includes at least one UV absorber, said method comprising providing in said preparation at least one effect pigment, wherein the at least one effect pigment has a laminar structure and contains titanium dioxide and at least one protective coating of silicon dioxide isolating the titanium dioxide from its environment to prevent titanium dioxide-induced breakdown of the UV absorber, whereby, depending on the angle of incidence of light, the skin would appear to have a different color or a different color shade. The effect pigments are pearlescent pigments, have a layer-on-substrate build-

up, and a transparent protective coating. The cosmetic preparation is a sunscreen agent.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Müller-Rees *et al.* disclose a UV-protective cosmetic preparation for application to skin comprising one or more UV absorbers and effect pigments, wherein the effect pigments have a laminar (e.g. "platelet") structure, contain titanium dioxide, and, depending on the angle of incidence of light, would appear to have a different color or a different color shade (abstract; Col. 1, Ins. 5-6, 37-52; Col. 2, Ins. 6-14, 18-24, 31, 41-51, 54-56; Col. 6, Ins. 25-67). The effect pigments can be pearlescent and have a layer-on-substrate build-up (Col. 2, Ins. 40-48). The cosmetic preparation is a sunscreen agent in the form selected from the group consisting of a cream, lotion, milk, and emulsion (Col. 2, Ins. 18-24, 31; Col. 6, Ins. 25-67). The UV absorber is a cinnamate UV absorber (Col. 6, Ins. 46-47).

Müller-Rees *et al.* also disclose a method for the production of a UV-protective cosmetic preparation that includes at least one UV absorber, said method comprising providing in said preparation at least one effect pigment, wherein the at least one effect pigment that has a laminar (e.g. "platelet") structure and contains titanium dioxide, and that, depending on the angle of incidence of light, would appear to have a different color or a different color shade (abstract; Col. 1, Ins. 5-6, 37-52; Col. 2, Ins. 6-14, 18-24, 31, 41-51, 54-56; Col. 6, Ins. 25-67). The effect pigments can be pearlescent, and have a layer-on-substrate build-up (Col. 2, Ins. 40-48). The cosmetic preparation is a sunscreen agent (Col. 2, Ins. 18-24, 31; Col. 6, Ins. 25-67).

Schmid *et al.* disclose a cosmetic preparation comprising one or more effect pigments, wherein the effect pigments have a laminar (e.g. “sheet-like”) structure, contain titanium dioxide, and have at least one protective coating of silicon dioxide isolating the titanium dioxide from its environment, wherein said effect pigments align in a parallel orientation, whereby, depending on the angle of incidence of light, the pigment(s) will have a different color or a different color shade (abstract; Col. 1, Ins. 4-31, 40-43, 53-54, 57-67; Col. 2, Ins. 5, 29-31, 33-35, 43-45, 47-48, 52, 53, 62-63; Col. 3, Ins. 14-20, 31-32; Col. 7, Ins. 12-19; Col. 8, Ins. 45-47, 56, 59-61; Col. 9, Ins. 1-3; Col. 10, Ins. 31, 33). The effect pigments are pearlescent pigments, have a layer-on-substrate build-up, and a transparent protective coating (abstract; Col. 1, Ins. 4-31, 40-43, 53-54, 57-67; Col. 2, Ins. 5, 52; Col. 3, Ins. 14-20; Col. 8, Ins. 45-47, 56-61).

Ascertainment of the Difference Between the Scope of the Prior Art and the Claims (MPEP §2141.012)

Müller-Rees *et al.* do not explicitly disclose that the effect pigments have at least one protective coating of silicon dioxide isolating the titanium dioxide from its environment. This deficiency is cured by the teachings of Schmid *et al.*

Finding of Prima Facie Obviousness Rational and Motivation (MPEP §2142-2143)

It would have been *prima facie* obvious for one of ordinary skill in the art at the time of the present invention to combine the respective teachings of Müller-Rees *et al.* and Schmid *et al.*, outlined *supra*, to devise applicants claimed UV-protective cosmetic preparation and method of making the same.

Müller-Rees *et al.* disclose a UV-protective sunscreen lotion comprising one or more UV absorbers and effect pigments, wherein the effect pigments have a laminar structure, can contain a titanium dioxide coating, and impart angle-dependent color effects (e.g. color flops). Since Schmid *et al.* disclose that effect pigments having a laminar structure, containing a titanium dioxide coating, and that impart angle-dependent color effects advantageously further contains an outer protective coating of silicon dioxide that encloses the titanium dioxide to protect the effect pigments in aqueous systems such as a lotion, one of ordinary skill in the art would be motivated to include a transparent protective coating of silicon dioxide on the effect pigments contained in the composition of Müller-Rees *et al.*, with the reasonable expectation that the resulting effect pigments will be successfully protected from the aqueous environment in which they are contained and retain their angle-dependent color effects.

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to Arguments

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new grounds of rejection.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID M. BROWNE whose telephone number is 571-270-1320. The examiner can normally be reached on Monday-Friday 7:30AM-5PM.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fereydoun Sajjadi can be reached on 571-272-3311. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos A. Azpuru/
Primary Examiner, Art Unit 1617

DAVID M. BROWE
Patent Examiner, Art Unit 1617